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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/081,132
Filing Date: February 21, 2002
Appellant(s): BLOOMBERG ET AL.

MAILED

SEP 12, 2005

Technology Center 2600

Frank J. DeRosa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8/8/2005 appealing from the Office action mailed 8/3/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct. It is noted that the summary of claimed subject matter contained in the brief does not include a summary of the claimed subject matter contained in claim 9.

Despite the appellant including arguments concerning claim 9, the appellant does not list claim 9 as being involved in an issue on appeal, nor does claim 9 comprise the subject matter that is at issue in claims 1, 2 and 3. Thus, since claim 9 is not involved in the appeal, a summary of claimed subject matter contained in claim 9 is not required.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. It is noted that the appellant's statement of the grounds of rejection to be reviewed on appeal does not indicate that claim 9 is involved in an issue on appeal. Despite the appellant including arguments concerning claim 9, the appellant did not include a summary of claimed subject matter contained in claim 9, nor does claim 9 comprise the subject matter that is at issue in claims 1, 2 and 3. Thus, based upon the appellant's brief, claim 9 is not involved in the appeal.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over OLSHANSKY (US 6,493,437 B1) in view of TRANDAL et al (US 2003/0081752 A1) and PATEL (US 2002/0174345 A1).

Regarding claim 1, OLSHANSKY discloses a system for enabling use of a computer terminal in a network to access or otherwise participate in at least one network-related function (billing and/or advertising) and voice communication over the network, comprising: authenticating means; means responsive to the authenticating means for enabling the computer terminal in the network to access or otherwise participate in the performance of at least one network-related function and voice communication over the network at least from each computer terminal which was authenticated (column 3 lines 1-28 and column 5 lines 11-55). However, OLSHANSKY does not disclose a telephone handset including a microphone and speaker coupled to provide signals to and receive signals from the computer terminal for voice communication; a finger image sensor coupled at least to provide signals to the computer terminal relating to a finger-image sensed by the finger-image sensor; and means for electronically authenticating a finger-image sensed by a finger-image sensor based on the finger-image-related signals provided to that computer terminal. TRANDAL et al discloses a telephone handset (140 of figure 1) including a microphone and speaker coupled to provide signals to and receive signals from the computer terminal for voice communication (paragraph 37). PATEL discloses a finger image

sensor coupled at least to provide signals to the computer terminal relating to a finger-image sensed by the finger-image sensor; and means for electronically authenticating a finger-image sensed by a finger-image sensor based on the finger-image-related signals provided to that computer terminal (figure 9 and paragraphs 92-98 and 12). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of OLSHANSKY, TRANDAL et al and PATEL. OLSHANSKY is silent as to the structure of the means to send and receive voice via the computer, thus forcing an artisan to implement a prior art solution. TRANDAL et al discloses a prior art means by which to send and receive voice via the computer that fills the void in OLSHANSKY's teaching. PATEL's finger image authentication enhances OLSHANSKY's teaching by providing a greater degree of security in the authentication in a way that is convenient to the user.

Regarding claim 2, see the parent claim for the subject matter this claim depends from. OLSHANSKY further discloses that the enabling means enables voice communication to and from only each terminal for which a sensed finger-image was authenticated (column 3 lines 1-32 and column 5 lines 11-55).

Regarding claim 3, OLSHANSKY discloses a system for enabling use of a computer terminal in a network to access or otherwise participate in at least one network-related function (billing and/or advertising) and voice communication between computer terminals in the network, comprising: a plurality of computer terminals in the

network; authenticating means; means responsive to the authenticating means for enabling the computer terminal that was authenticated to access or otherwise participate in the performance of at least one network-related function and voice communications over the network (column 3 lines 1-28 and column 5 lines 11-55). However, OLSHANSKY does not disclose a microphone and a speaker coupled to each of the plurality of computer terminals to provide signals to and receive signals from the computer terminal for voice communication; a finger image sensor at least to provide signals to the computer terminal relating to a finger-image sensed by the finger-image sensor; and means for electronically authenticating a finger-image sensed by a finger-image sensor based on the finger-image-related signals provided to that computer terminal. TRANDAL et al discloses a telephone handset (140 of figure 1) including a microphone and speaker coupled to provide signals to and receive signals from the computer terminal for voice communication (paragraph 37). PATEL discloses a finger image sensor coupled at least to provide signals to the computer terminal relating to a finger-image sensed by the finger-image sensor; and means for electronically authenticating a finger-image sensed by a finger-image sensor based on the finger-image-related signals provided to that computer terminal (figure 9 and paragraphs 92-98 and 12). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of OLSHANSKY, TRANDAL et al and PATEL. OLSHANSKY is silent as to the structure of the means to send and receive voice via the computer, thus forcing an artisan to implement a prior art solution. TRANDAL et al discloses a prior art means by which to send and receive

voice via the computer that fills the void in OLSHANSKY's teaching. PATEL's finger image authentication enhances OLSHANSKY's teaching by providing a greater degree of security in the authentication in a way that is convenient to the user.

Regarding claim 4, see the parent claim for the subject matter this claim depends from. OLSHANSKY further discloses that at least one of the computer terminals includes the means for authenticating (column 3 lines 1-28 and column 5 lines 11-55).

Regarding claim 5, see the parent claim for the subject matter this claim depends from. OLSHANSKY further discloses comprising a computer in the network, other than the computer terminals, that include the means for authenticating (column 3 lines 1-28 and column 5 lines 11-55).

Regarding claim 6, see the parent claim for the subject matter this claim depends from. OLSHANSKY further discloses that at least one of the computer terminals includes the means responsive to the authenticating means (column 3 lines 1-28 and column 5 lines 11-55).

Regarding claim 7, see the parent claim for the subject matter this claim depends from. OLSHANSKY further discloses that at least one of the computer terminals includes the means responsive to the authenticating means (column 3 lines 1-28 and column 5 lines 11-55).

Regarding claim 8, see the parent claim for the subject matter this claim depends from. OLSHANSKY further discloses that the handset is keypadless and each computer terminal includes a computer input device by which information for accessing or otherwise participating in voice communications over the network is input to the computer terminal (figure 3). In the alternative, TRANDAL et al further discloses that the handset is keypadless and each computer terminal includes a computer input device by which information for accessing or otherwise participating in voice communications over the network is input to the computer terminal (figure 1).

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over OLSHANSKY (US 6,493,437 B1) in view of TRANDAL et al (US 2003/0081752 A1), CHANG et al (US 2002/0122415 A1) and PATEL (US 2002/0174345 A1).

Regarding claim 9, OLSHANSKY discloses an apparatus for voice communication over a network through a computer terminal and for authentication, comprising: means associated with at least one of the computer terminal and the network for authenticating, and means associated with at least one of the computer terminal and the network responsive to the authenticating means for enabling the computer terminal in the network to participate in voice communication over the network at least from each computer terminal that was authenticated (column 3 lines 1-28 and column 5 lines 11-

55). However, OLSHANSKY does not disclose a telephone handset including: a microphone; a speaker; a finger-image sensor; circuitry coupled to the microphone and speaker which at least converts between analog and digital signals; an interface coupling the finger-image sensor and the circuitry with the computer terminal; and a finger-image being sensed by the finger-image sensor based on the finger-image-related signals provided to that computer terminal. TRANDAL et al discloses a telephone handset (140 of figure 1) including a microphone and speaker coupled to provide signals to and receive signals from the computer terminal for voice communication (paragraph 37). It is noted that TRANDAL et al only discloses that digital to analog conversion takes place but does not specify that it take place in the handset. CHANG et al discloses that a handset for voice over IP is connected to a computer via a USB connection (paragraphs 14-19). Since USB is a digital connection the handset inherently would have to include a digital to analog means. Moreover, PATEL discloses a finger-image sensor coupled to a telephone for use in authentication that uses a finger-image being sensed by the finger-image sensor based on the finger-image-related signals provided to that computer terminal (figure 9 and paragraphs 92-98 and 12). Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of OLSHANSKY, TRANDAL et al, CHANG et al and PATEL. OLSHANSKY is silent as to the structure of the means to send and receive voice via the computer, thus forcing an artisan to implement a prior art solution. TRANDAL et al discloses a prior art means by which to send and receive voice via the computer that fills the void in OLSHANSKY's teaching.

TRANDAL is silent as to the location of the digital to analog means. CHANG et al evidences that it is known to include the digital to analog means in the handset. A USB connection is beneficial in that it would allow the handset to connect to any computer that has the known and widely implemented USB connection. PATEL's finger image authentication enhances OLSHANSKY's teaching by providing a greater degree of security in the authentication in a way that is convenient to the user.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over OLSHANSKY (US 6,493,437 B1) in view of TRANDAL et al (US 2003/0081752 A1), CHANG et al (US 2002/0122415 A1) and PATEL (US 2002/0174345 A1) and further in view of an examiner's official notice.

Regarding claim 10, see the parent claim for the subject matter this claim depends from. However, neither OLSHANSKY, TRANDAL et al, CHANG et al, nor PATEL disclose a first universal serial bus (USB) interface coupled to the integrated circuitry; a second USB interface coupled to the finger-image sensor; the interface coupling the finger-image sensor and the circuitry with the computer terminal comprising a USB hub coupled to the first and second USB interfaces. Nevertheless the examiner takes official notice that it was known in the art at the time the invention was made to have 2 devices, each with USB interfaces, connected to a USB hub, which is then connected to a computer. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have a first universal serial bus

(USB) interface coupled to the integrated circuitry; a second USB interface coupled to the finger-image sensor; the interface coupling the finger-image sensor and the circuitry with the computer terminal comprising a USB hub coupled to the first and second USB interfaces. Use of a USB hub is beneficial in that it allows more than one device to communicate with a single USB port on a computer. This permits computers to have a limited number of USB ports while still being able to communicate with many USB devices.

Regarding claim 11, see the parent claim for the subject matter this claim depends from. CHANG et al further discloses a cable coupled to the USB hub and connectable to a USB port of a computer terminal (paragraph 14).

Regarding claim 12, see the parent claim for the subject matter this claim depends from. TRANDAL et al further discloses that the function of a codec (paragraphs 37).

(10) Response to Argument

Regarding claims 1 and 3, the appellant argues that neither OLSHANSKY, TRANDAL nor PATEL, neither alone or in combination, discloses that OLSHANSKY does not teach means responsive to the authenticating means that enable the computer terminal in the network to access or otherwise participate in performance of at least one

network-related function and voice communication over the network at least from each computer terminal for which a sensed finger-image was authenticated. The basis of the appellant's position is the argument that OLSHANSKY does not disclose the enablement of both telephone service and a network related function.

The examiner would like to first point out that the limitation in question uses alternative language. The limitation calls for of at least one... network-related function ...and... voice communication (emphasis added). Thus, to meet the limitation as written, OLSHANSKY would only have to teach either a network-related function or a voice communication. At the least, and as argued by the appellant, OLSHANSKY discloses the voice communication aspect. Therefore, since claims 1 and 3 use alternative language, OLSHANSKY undisputedly teaches the limitation at issue.

Even if the language of the limitation at issue is not considered alternative, OLSHANSKY teaches that that both a network-related function and a voice communication are performed. Undisputed is the fact that OLSHANSKY teaches the performance of voice communication and services incidental to a telephone call, such as providing billing information or advertisements on the calling party's display. At issue is whether services incidental to a telephone call, such as providing billing information or advertisements on the calling party's display, are disqualified from being considered a network-related function. The applicant argues that the services incidental to a telephone call do not qualify as a network related function and instead qualify as voice communications. The examiner respectfully disagrees. The applicant's claim limitation merely uses the language "network-related function". This language is broad and

neither this language nor the remaining language in the claim limits the “network-related function” from being related to the telephone service. Moreover, in lines 2-4 of page 13 of the applicant’s specification, it is indicated by example that a network function includes information delivery. Further, the applicant’s specification does not limit a network-related function from being related to the telephone service. As such, providing billing information or advertisements on the calling party’s display (both involve information delivery), while related to telephone service, does meet limitation of “network-related function” when considering both the claim and specification. The appellant further argues that neither TRANDAL nor PATEL teaches the limitation in question. However, OLSHANSKY was cited as teaching the limitation at issue and not TRANDAL or PATEL. For the preceding reasons the examiner maintains that OLSHANSKY teaches the performance of both network-related function and a voice communication.

Regarding claim 9, the appellant argues that the rejection should be reversed for the reasons given with respect to claims 1 and 3. However, claim 9 does not include the limitation of “the performance of at least one... network-related function ...and... voice communication.” Instead, claim 9 only calls for the performance of a voice communication. Since the limitation that appellant is arguing with respect of claims 1 and 3 are not contained in claim 9, the appellant’s arguments regarding claims 1 and 3 do not apply toward claim 9. If anything, the appellant’s arguments regarding claims 1 and 3 evidence that OLSHANSKY teaches the voice communication aspect as it

pertains to claim 9. The appellant further argues that CHANG does not teach the voice communication aspect. However, OLSHANSKY was cited as teaching the voice communication aspect and not CHANG, TRANDAL or PATEL. For the preceding reasons the examiner maintains that OLSHANSKY teaches the performance of voice communication.

Regarding claim 2, the appellant, for the first time, argues that that OLSHANSKY dose not teach the limitation of the enabling means enabling voice communication to and from each terminal for which a sensed finger-image was authenticated. The appellant goes on to suggest that the language in the claim means that *both terminals involved in voice communication* are enabled only after authentication of a sensed finger-image at each terminal (emphasis added). However, it is noted that the features upon which applicant relies (i.e., both terminals involved in voice communication) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As the examiner is reading the language of the claim, all that is required to meet the limitation is the enabling of voice communication to and from each terminal for which a sensed finger-image was authenticated. In other words, the claim does not require that both sides of a conversation have had the voice communication enabled via authenticated sensed finger-images. What is required is that for any terminal for which a sensed finger-image is authenticated that voice communication be enabled. The appellant in arguing claims

1 and 3 concedes that OLSHANSKY teaches a terminal that after authentication enables voice communication. The passage of OLSHANSKY cited in the rejection of claim 2, demonstrates that OLSHANSKY contemplates more than one user terminal operating under the principals of his teaching. The issue of the authentication being done by a sensed finger-image at each terminal is covered in claim 1. Thus, OLSHANSKY in view of TRANDAL and PATEL disclose enabling means that enables voice communication to and from each terminal for which a sensed finger-image was authenticated. The appellant further argues that neither TRANDAL nor PATEL teaches the limitation in question. However, OLSHANSKY was cited as teaching the limitation at issue and not TRANDAL or PATEL. For the preceding reasons, the examiner believes that the rejection of claim 2 should be maintained.

Regarding claims 4-8 and 10-12, the appellant indicates that they are allowable due to their dependence on claims 1, 3 or 9. For the reasons given above with respect to claims 1, 3 and 9 the examiner maintains that rejections on claims 4-8 and 10-12 should be maintained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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